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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,617	10/01/1999	DAVID MICHAEL SHACKELFORD	TU9-99-029	5644

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EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 11/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/409,617

Applicant(s)

SHACKELFORD, DAVID MICHAEL

Examiner

Benjamin E Lanier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment of claims 1, 4, 5, 6, 9, 11, 12, 14, 16, 19, 22, 24-27, 30-32, 35-37, and 39 have been fully considered and are entered.

### ***Response to Arguments***

2. Applicant's arguments, see Amendment A, filed 02 October 2003, with respect to the rejection(s) of claim(s) 1-40 under Medveczky have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ross, U.S. Patent No. 5,553,139.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 4, 7-12, 14-16, 18-27, 29, 30, 33-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross, U.S. Patent No. 5,553,139. Referring to claims 1, 3, 7, 12, 14, 16, 18, 20, 21, 25, 27, 29, 33, 38, Ross discloses an electronic license distribution system wherein the user of a software package must request a license for the software in order to use the software. The user receives an enabler key (code) that is used to decrypt the license (encrypted generated message) upon receipt of payment (request), which meets the limitations of receiving a request for software and generated an encrypted message and determining there is a code available to the

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computer and decrypting the encrypted message with the determined code. Once the license has been decrypted the user can then access the software package using the software license (Col. 7, line 23 – Col. 8, line 24).

Referring to claims 4, 8, 9, 11, 19, 22, 24, 26, 30, 34, 35, 37, 39, Ross discloses that a checksum is generated at the user computer using the enabler key (public key) and that when the license is received, it is verified by comparing it's own checksum with that of the enabler key at the user computer. This meets the limitation of determining whether the decrypted response includes the generated message transmitted to the second computer system, and the second computer system being authorized to access the software if the response includes the generated message (Col. 7, lines 33 – 55).

Referring to claims 10, 15, 23, 36, 40, Ross discloses the licensing process prompting the installer for a product type and version and the desired features (configuration data)(Col. 7, lines 33-36).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 6, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross, U.S. Patent No. 5,553,139, in view of Komura, U.S. Patent No. 5,994,307. Referring to claims 5, 6, 31, and 32, Ross discloses an electronic license distribution system wherein the user of a software package must request a license for the software in order to use the software. The

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user receives an enabler key (code) that is used to decrypt the license (encrypted generated message) upon receipt of payment (request), which meets the limitations of receiving a request for software and generated an encrypted message and determining there is a code available to the computer and decrypting the encrypted message with the determined code. Once the license has been decrypted the user can then access the software package using the software license (Col. 7, line 23 – Col. 8, line 24). Ross does not disclose using time stamps as an offset in the transmitted messages. Komura discloses a packet transmission system wherein time stamp offset values are attached to data packets (message)(Col. 7, lines 22-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use time stamp offset values in the system for license distribution for synchronizing purposes taught in Komura (Col. 6, lines 40-67).

7. Claims 2, 13, 17, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross, U.S. Patent No. 5,53,139, in view of Jia, U.S. Patent No. 5,991,402. Referring to claims 2, 13, 17, 28, Ross discloses an electronic license distribution system wherein the user of a software package must request a license for the software in order to use the software. The user receives an enabler key (code) that is used to decrypt the license (encrypted generated message) upon receipt of payment (request), which meets the limitations of receiving a request for software and generated an encrypted message and determining there is a code available to the computer and decrypting the encrypted message with the determined code. Once the license has been decrypted the user can then access the software package using the software license (Col. 7, line 23 – Col. 8, line 24). Ross does not disclose what material the software package will be comprised of. Jia discloses a system for software on demand and software subscription wherein the software

packages contain audio, video, and text data (Col. 8, lines 57-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the software packages of Ross to include audio, video, and text data because it is well known for software packages to contain such data as taught in Jia (Col. 8, line 57 – Col. 9, line 36).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Benjamin E. Lanier



GILBERTO BARRON  
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